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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,005	12/02/2003	Baruch Segal	3116/1	3160
44596 7590 06/11/2009 DR. MARK M. FRIEDMAN C/O BILL POLKINGHORN - DISCOVERY DISPATCH 9003 FLORIN WAY UPPER MERLBORO, MD 20772				
EXAMINER				
STULIL, VERA				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
06/11/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/725,005

Applicant(s)

SEGAL ET AL.

Examiner

VERA STULII

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9 and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (US 2003/0219513) in view of Mackay (UK 2,119,633), Matson (US 2006/0160050) and Riling et al (US 5,582,028) for the reasons as stated in the Office action mailed January 27, 2009.

Response to Arguments

Applicant's arguments filed February 19, 2009 have been fully considered but they are not persuasive.

On page 5 of the Reply to the Office action mailed January 27, 2009, Applicants state that the assembly as disclosed in Gordon is not a kit and is not portable. In response to this argument, it is noted that the assembly of Gordon appears to be a portable kit in the absence of showing of a contrary. There are no teachings in the Gordon reference that prevent it from being portable. Assemblage of elements put together and used together to reduce consumer's weight. In any case, the fact that the claimed kit is portable is not sufficient by itself to patentably distinguish over the prior art kit unless there are new or unexpected results (see MPEP 2144.04).

On pages 5-6 of the Reply, Applicants state that "[t]he "levels" on the presentation stand of FIG. 5b have nothing in common with the levels in the portable kit recited in claims 1 and 18 as a key inventive feature and limitation". In

response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Matson is relied upon as a teaching of organizing foods in a vertical arrangement with different values of controlled variable (in this case of volume). Further in regard to the shape/configuration/stacking, it is noted that the configuration (shape) of the claimed kit is a matter of choice which the person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed kit is significant (See MPEP 2144.04 (IV)). Also, rearranging/shifting foods in the kit would not have modified the operation of the claimed kit. Further in this regard, it is noted that the particular shape of the kit, and arrangement of the foods in the kit, would have been a matter of personal choice and design preference.

On page 6 of the Reply, Applicants state that "[i]n essence, the Examiner's position appears to be that Gordon discloses essentially all of the limitations of claims 1 and 18". Examiner respectfully disagrees. Claims 1-9 and 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gordon (US 2003/0219513) in view of Mackay (UK 2,119,633), Matson (US 2006/0160050) and Riling et al (US 5,582,028). Claims are rejected in view of the art taken as a whole.

On page 6 of the Reply, Applicants state that "Gordon actually teaches away from the present invention by focusing on purpose on the key feature that all the foods must have a predetermined and substantially uniform content of at least one nutritional

component and by emphasizing calories as the key embodiment of the nutritional component. Examiner respectfully disagrees. Gordon discloses an assembly of food units comprising a plurality of food units, each food unit having a predetermined content of at least one nutritional component such carbohydrate ([0031], [0066], [0072], [0074], [0087]).

On page 6 of the Reply, Applicants state that "[w]ith regard to Mackay and Matson, Applicant respectfully submits that neither teach all the limitations missing in Gordon". In response to this argument, it is noted that since Gordon discloses providing foods in individual containers based on at least one nutritional component, and Mackay discloses providing foods in individual portions based on carbohydrates, and Matson discloses arranging foods in levels or sequences based on different values of the controlled variable, it would have been obvious to modify Gordon and to employ plurality of foods having a predetermined carbohydrate content and arrange them, so that they are grouped by the carbohydrate content for the purpose of diet control in view of the art taken as a whole. The references are seen to have been a teaching to one of ordinary skill in the art to package on the basis of any nutrient desired, including carbohydrates, and arrange them in any sequence desired.

On page 6 of the Reply, Applicants state that "[a]pplicant fails to understand how Mackay is relevant to the present invention at all". On page 7 of the Reply, Applicants state that Mackay also teaches away from the present invention. In response to these arguments, it is noted that Mackay discloses restricting carbohydrate intake by providing food kit with defined carbohydrate content; providing plurality of foods with a known

carbohydrate content and organizing foods in a portable device according to optimal carbohydrate intake, and freely consuming foods having variable carbohydrate content. Mackay discloses the feature of variable carbohydrate content from one compartment to another, which are marked in a different manner, e.g. by color coding, to indicate different levels of carbohydrate content (i.e. low, moderate and high).

On page 7 of the Reply, Applicants state that "it is amply clear that Matson's system works always with different dietary food groups (e.g. proteins and carbohydrates), and is not a carbohydrate only diet based on a total or predetermined carbohydrate content that equals a daily carbohydrate intake (as claimed in claims 1 and 18 of the present invention)" and that Matson also teaches away from the present invention. On page 8 of the Reply, Applicants state that "Matson has no concept of a predetermined total carbohydrate content in the kit matching a daily carbohydrate intake, as claimed in claims 1 and 18". In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Matson discloses a system and method that utilizes a set of fixed volume containers that are graduated to provide a user means to control the volume of food consumed over time (Abstract). In accordance with the instant invention, the contents of the containers are consumed over time according to a schedule which identifies the appropriate containers and the frequency of the meals to be consumed

each day (Abstract). Therefore, Matson discloses organizing foods in a vertical arrangement with different values of controlled variable (in this case of volume).

On page 8 of the Reply, Applicants state that “the configuration of the kit is not a matter of choice but of a definite design”. Examiner respectfully disagrees, the particular arrangement of foods in the kit is a matter of choice and design. The references disclose controlling various variables that effect consumer’s weight (including control of carbohydrates consumed) by orienting foods either horizontally or vertically in separate receptacles. How one chooses to arrange or orient food receptacles having predetermined daily content of carbohydrates would have been an obvious matter of choice and design. Applicants are not the first to provide receptacles of fixed nutrient amount, for example, carbohydrates. Applicants are also not the first to provide receptacles where receptacles vary in amount of carbohydrates. Applicants are also not the first to orient a group of receptacles that contain varying amount of foods in a vertical array, which indicates to the consumer varying amount of products based on the position in the array. It would have been obvious to apply these teachings to any nutritional component control, and to therefore modify Gordon and to employ a stack of arrays would have been fairly taught by the art taken as a whole.

On page 9 of the Reply, Applicants state that “Riling et al. fail to disclose any of the limitations recited in claims 1 and 18 which are missing in Gordon”. In response to applicant’s arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA

1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Riling et al is relied upon as a teaching of conventionality in the art to employ a cooling pack to prevent spoilage. To modify combination of Gordon, Matson and Mackay and employ a cooling pack to prevent spoilage would have been an obvious result effective variable and an obvious function of the type of food and the preserving time desired. Therefore, it would have been obvious to modify the combined teachings of Gordon, Matson and Mackay and use cooling packs in a portable kit/device/ apparatus, if necessary, in order to preserve the freshness of foods.

In response to applicants argument that "Gordon, Mackay and Matson each teaches away in different ways from the invention. Therefore, the combination of Gordon, Mackay, Matson and Rilling et al. teaches away from the invention", Applicants are referred to the response to the arguments regarding each reference as stated above.

In response to applicants' argument regarding specific arrangement of foods in the kit, it is noted that the configuration (shape) of the claimed kit is a matter of choice which the person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed kit is significant (See MPEP 2144.04 (IV)). Also, rearranging/shifting foods in the kit would not have modified the operation of the claimed kit. Further in this regard, it is noted that the particular shape of the kit, and arrangement of the foods in the kit, would have been a matter of personal choice and design preference. The kit contains plurality of foods having some kind of coding, indicating amounts of carbohydrates, the foods are

selected having a predetermined daily content of carbohydrates. The specific arrangement of the foods will not effect reduction of weigh in the consumer or amount of carbohydrates consumed during the day.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VERA STULII whose telephone number is (571)272-3221. The examiner can normally be reached on 7:00 am-3:30 pm, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steve Weinstein/
Primary Examiner, Art Unit 1794

VS